

Response  
Application No. 10/766,043  
Attorney Docket No. 042058

**REMARKS**

Claims 1-26 are pending.

**Applicants' Response to the Claim Rejections under 35 U.S.C. §103(a)**

Claims 1-6, 8-18, 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,772,038 ("Kadono") in view of U.S. Patent No. 6,535,788 ("Yoshida"). Applicants respectfully traverse on the basis that: first, each and every limitation of the claimed invention is not set forth in the cited references in as clear detail as claimed; and, second, there is no teaching or motivation which suggests the combination.

First, as noted in the prior response, Kadono is directed to modelling based on CAD data. The Office asserts that Kadono discloses the third element of claims 1, 20 and 21; namely, a case search unit which searches the working case storage unit. This third element is directly related to a working case storage unit, which the Office admits is not disclosed in Kadono. Pages 3 and 4 of the current Office Action. Hence, applicants respectfully submit that there is no basis to assert that Kadono describes a case searching unit equivalent to the currently claimed limitation when the Office admits the data base to be searched is not disclosed. The section of Kadono which the Office cites to for this element, col. 2, lines 53-64, is referring to the information compiled to generate a virtual work piece. There is no case searching unit which searches working cases of past working conditions as claim 1 requires set forth in Kadono. Hence, Kadono does not teach each of the limitations of the presently claimed invention for which it is relied upon in the rejection.

Second, in regard to the combinability of Kadono with Yoshida, as noted above, Kadono is based on CAD modelling. Further, Yoshida is cited for the disclosure of a change operation for a control device of a machine tool. Yoshida discloses that when an operator makes a change in the processing conditions, the change is stored in a user data base. The change is analyzed to determine if the change should be incorporated into the regular design routine. See col. 18, line 11 to col. 19, line 15 and Fig. 31. The Office asserts that one of skill in the art would be motivated to incorporate this feature of Yoshida into the device of Kadono to derive the current invention. Specifically, the Office Action states, as the motivation to combine, that the change operation of Yoshida “would provide for the purpose of judging whether or not the changing operation is appropriate and also for reflecting the changing operation on the creation and decision of the toolpath and the processing condition.” This reason for motivation is a restatement of the utility described in Yoshida. See col. 4, lines 1-6. Applicants respectfully traverse.

There is no basis for one of skill in the art to incorporate past work changes into CAD modelling. The idea of Kadono is for generating work pieces that have no past cases, but are newly designed on CAD. Hence, the skilled artisan has no basis to incorporate case histories of changes made to a design which is only in the design phase. Hence, applicants respectfully submit that one of skill in the art would not be motivated to combine the cited references to derive the current invention.

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In view of the above remarks, Applicants submit that the claims, as previously presented, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read "Michael J. Caridi", is written over a horizontal line.

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